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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/994,553	11/27/2001	Michael W. Perryman	1248-38	1087

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Charles J. Meyer  
Woodard, Emhardt, Naughton, Moriarty and McNett  
Bank One Center/Tower  
111 Monument Circle, Suite 3700  
Indianapolis, IN 46204-5137

EXAMINER

BLAU, STEPHEN LUTHER

ART UNIT

PAPER NUMBER

3711

DATE MAILED: 11/21/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

S.M.

**Office Action Summary**

Application No.

09/994,553

Applicant(s)

PERRYMAN ET AL.

Examiner

Stephen L. Blau

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 August 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 28-61 is/are pending in the application.
- 4a) Of the above claim(s) 33-52 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 28-32 and 53-61 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. Information Disclosure Statement dated 27 November 2001 (Paper No. 2) has been considered and is included.

### ***Specification***

2. The disclosure is objected to because of the following informalities: On page 9 line 22 through page 10 line 9 it states for figure 6 that the core is reference number "20" and an outer layer is reference number "25" when it appears that in figure 6 the core is reference number "25" and an outer layer is reference number "20". Figure 5 appears to read the same as the description. It may be that figure 6 is incorrect.

Appropriate correction is required.

### ***Drawings***

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "20" and "25" have both been used to designate a core and an outer layer in figures 5-6 . A proposed drawing correction or corrected drawings

are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 112***

4. The arguments with respect to the rejection of claims 28-32 under 35 U.S.C. 112, first and second paragraph, are agreed with and the rejections have been removed.

### ***Double Patenting***

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 28-32 and 53-61 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10 of U.S. Patent No. 6,354,960 in view of Kusumoto (5,427,373).

Claims 1-10 of U.S. Patent No. 6,354,960 have the additional requirement that there is a first and second metal which are different. Kusumoto discloses a shaft having fibers at a butt end (21) and at a hosel end (19) (Fig. 24). Kusumoto does not specifically state that the fibers are the same in sheets 19 and 21 however an artisan skilled in the art of placing reinforced fibers at a butt end and a hosel end would have used suitable fibers in which the fibers are the same. In view of the patent of Kusumoto it would have been obvious to modify the shaft of claims 1-10 of U.S. Patent No. 6,354,960 to not have two metals both being different in order to simplify the manufacturing process by using only one type of metal coated fibers.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 28 and 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over McIntosh in view of Akatsuka (5,437,450).

McIntosh discloses a method of forming a golf club shaft (Col. 1, Lns. 35-45) sheet rolling a plurality of fiber reinforced graphite plies around a mandrel to form a shaft core (30) (Col. 6, Lns. 6-21), nickel coated fibers in at least one outer ply (31)

around a core (Col. 6, Lns. 6-21), and placing a scrim layer around an at least one outer ply (Col. 5, Lns. 13-20).

McIntosh lacks an at least one outer ply being filament wound. Akatsuka discloses forming a shaft with an inner layer formed of sheet rolling and an outer layer formed of fiber winding in order to have a shaft with improved strength and torsional rigidity (Col. 1, Lns. 21-48). In view of the patent of Akatsuka it would have been obvious to modify the shaft of McIntosh to have a method of an at least one outer ply being filament wound in order to have an improved strength and torsional rigidity.

9. Claims 28-29 and 53-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over McIntosh in view of Akatsuka (5,354,054) and Inoue.

McIntosh discloses a method of forming a golf club shaft (Col. 1, Lns. 35-45) sheet rolling a plurality of fiber reinforced graphite plies around a mandrel to form a shaft core (30) (Col. 6, Lns. 6-21), nickel coated fibers in at least one outer ply (31) around a core (Col. 6, Lns. 6-21), and placing a scrim layer around an at least one outer ply (Col. 5, Lns. 13-20).

McIntosh lacks an at least one outer ply being filament wound and at least one filament wound ply wound to uniformly add an amount of weight to a shaft. Akatsuka (5,354,054) discloses a shaft being made of either sheeting winding or filament winding with filament winding preferred because no seams are formed (Col. 5, Lns. 11-17). Inoue discloses an advantage of using a filament winding process is that the filament content is good and a disadvantage of a sheet winding is that the control of filament

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orientation is poor (Col. 2, Lns. 45-68) and a uniformly thick outer layer (85). In view of the patents of Akatsuka and Inoue it would have been obvious to modify the method of manufacturing a shaft of McIntosh to have the inner and outer layers formed by a filament winding process in order to have a shaft with no seams formed, a good filament content, and better control of the filament orientation. In view of the patents of Akatsuka and Inoue it would have been obvious to modify the method of manufacturing a shaft of McIntosh to have at least one filament wound ply wound to uniformly add an amount of weight to a shaft in the form of an outer layer with a uniform thickness along the length of a shaft in order to have shaft which tapers from a butt end to a tip end with no discontinuities visually pleasing to a golfer.

9. Claims 29-32 and 54-57 are rejected under 35 U.S.C. 103(a) as being unpatentable over McIntosh in view of Akatsuka (5,437,450) as applied to claim 28 and 53 above, and further in view of Kusumoto.

McIntosh lacks at least one filament wound ply wound to uniformly add an amount of weight to a shaft, at least one out ply being uniformly wound over a portion of a shaft to concentrate an amount of weight in a location on a shaft, a shaft having a length and a hosel portion wherein an outer ply is uniformly wound around a hosel portion for a distance approximately one third or less of a shaft's length, and a shaft having a length and a grip portion wherein an outer ply is uniformly wound around a grip portion for a distance approximately one third or less of a shaft's length.

Kusumoto discloses fiber reinforcement uniformly located along a length of a shaft (15 or 359), at a hosel end of a shaft (19) and a grip end of a shaft (21) about one third the length of the shaft in order to modulate a kick point of a shaft (Col. 1 Ln. 55 through Col. 2, Ln. 10, Figs. 23-24). In view of the patent of Kusumoto it would have been obvious to modify the method of forming a shaft of McIntosh to have at least one filament wound ply wound to uniformly add an amount of weight to a shaft in the form of an outer layer along the length of a shaft in order to have shaft which tapers from a butt end to a tip end with no discontinuities. In view of the patent of Kusumoto it would have been obvious to modify the method of forming a shaft of McIntosh to have a shaft having at least one out ply being uniformly wound over a portion of a shaft to concentrate an amount of weight in a location on a shaft, a length and a hosel portion wherein an outer ply is uniformly wound around a hosel portion for a distance approximately one third or less of a shaft's length, and a shaft having a length and a grip portion wherein an outer ply is uniformly wound around a grip portion for a distance approximately one third or less of a shaft's length in order to have a shaft that has a shaft-with-reinforcement-at-a-tip-end-and-a-butt-end-to-modulate-a-kick-point.

9. Claims 58-61 are rejected under 35 U.S.C. 103(a) as being unpatentable over McIntosh in view of Kusumoto.

McIntosh discloses a method of forming a golf club shaft (Col. 1, Lns. 35-45) sheet rolling a plurality of fiber reinforced graphite plies around a mandrel to form a



shaft core (30) (Col. 4, Lns. 41-53, Col. 6, Lns. 6-21), nickel coated fibers in at least one outer ply sheet (31) around a core (Col. 4, Lns. 41-53, Col. 6, Lns. 6-21),

McIntosh lacks at least one filament wound ply wound to uniformly add an amount of weight to a shaft, a shaft having a length and a hosel portion wherein an outer ply is uniformly wound around a hosel portion for a distance approximately one third or less of a shaft's length, and a shaft having a length and a grip portion wherein an outer ply is uniformly wound around a grip portion for a distance approximately one third or less of a shaft's length.

Kusumoto discloses fiber reinforcement uniformly located along a length of a shaft (15 or 359), at a hosel end of a shaft (19) and a grip end of a shaft (21) about one third the length of the shaft in order to modulate a kick point of a shaft (Col. 1 Ln. 55 through Col. 2, Ln. 10, Figs. 23-24). In view of the patent of Kusumoto it would have been obvious to modify the method of forming a shaft of McIntosh to have at least one filament wound ply wound to uniformly add an amount of weight to a shaft, a length and a hosel portion wherein an outer ply is uniformly wound around a hosel portion for a distance approximately one third or less of a shaft's length, and a shaft having a length and a grip portion wherein an outer ply is uniformly wound around a grip portion for a distance approximately one third or less of a shaft's length in order to have a shaft that has a shaft with reinforcement at a tip end and a butt end to modulate a kick point.


***Response to Arguments***

10. Applicant's arguments with respect to claims 28-32 have been considered but are moot in view of the new ground(s) of rejection. As such this office action has not been made final. The declarations of Michael W. Perryman (6/12/01, 8/20/02) and Howard Miller (8/20/02) have been considered but are not convincing. The declarations did not convince the examiner that the success is not the result in advertising and consumption by purchasers normally tied to applicant or assignee but was due to the features as claimed. With respect to the prior art, McIntosh discloses very close to the applicants claimed invention and it is known to interchange methods of sheet rolling and filament winding using the advantages of each.

***Conclusion***

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steve Blau whose telephone number is (703) 308-2712. The examiner is available Monday through Friday from 8 a.m. to 4:30 p.m.. If the examiner is unavailable you can contact his supervisor Paul Sewell whose telephone number is (703) 308-2126. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0858.

Slb 19 November 2002

  
**STEPHEN BLAU**  
**PRIMARY EXAMINER**